Application No. 08/935,116
Reply to the Board Decision dated September 9, 2004 and
the final Office Action dated September 18, 2001

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 8-39 are presently active; Claims 17, 22, 27, 30, 33, and 34 having been presently amended.

Following the Board decision dated September 9, 2004 that affirmed-in-part the final Office Action dated September 18, 2001 and that presented a new grounds for rejection, the status of the claim rejections is as follows:

Claims 8, 9, 12, and 13 were rejected under 35 USC 102(b) as being anticipated by Creekmore (U.S. Patent No. 4,109,238). *This rejection was reversed by the Board decision.* Claims 33-39 were rejected under 35 USC 102(b) as being anticipated by Goldman et al (U.S. Patent No. Re 30,580). *This rejection was reversed by the Board decision.* Claims 15 and 16 were rejected under 35 USC 103(a) as being unpatentable over Creekmore (U.S. Patent No. 4,910,672) in view of Off et al (U.S. Patent No. 4,910,672). *This rejection was reversed by the Board decision.* Claims 10, 11, and 14 were rejected under 35 USC 103(a) as being unpatentable over Creekmore in view of Off et al in further view of Tai (U.S. Patent No. 4,908,7610). *This rejection was reversed by the Board decision.* Claims 17-32 were rejected under 35 USC 103(a) as being unpatentable over Creekmore in view of Off et al in view of Tai in further view of Bigari (U.S Patent No. 5,010,485). *This rejection was not reversed by the Board decision.* Claims 33-39 were rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter. *This rejection was reversed by the Board decision.* Claims 8, 9, 12, and 13 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 23 of U.S. Patent No. 5,305,196. *This rejection was reversed by the Board decision.* Claims 10, 11, and 14 were rejected under the judicially created doctrine of obviousness-type double

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patenting as being unpatentable over Claims 18 and 26 of U.S. Patent No. 5,201,010 in view

of Tai. *This rejection was reversed by the Board decision.* Claims 15 and 16 stand rejected

under the judicially created doctrine of double patenting over claim 12 of U.S. Patent No.

5,659,469. *This rejection was reversed by the Board decision.* Claims 17-32 stand rejected

under the judicially created doctrine of obviousness-type double patenting as being

unpatentable over Claims 1 and 3 of the U. S. Patent No 5,529,560 [sic; 5,592,560]. *This*

rejection was reversed by the Board decision. Claims 33-39 stand rejected under the

judicially created doctrine of double patenting over Claims 1, 2, and 3 of U.S. Patent No.

5,592,560. *This rejection was reversed by the Board decision.*

The Board decision contained a new ground for rejection. Claim 33 was rejected

under 35 U.S.C. 102(b) as being anticipated by Creekmore.

In light of the reversal by the Board of almost all the rejections formerly outstanding

in this case, it is respectfully submitted that Claims 8-16, having no outstanding rejections,

patentably define over the applied prior art.

Regarding the outstanding rejections of Claims 17-39, the Board in its decision notes

that:

> We note at the outset that independent claims 17 and 22 do not recite
> manipulating the dollar amount and time of purchase. Only independent
> claims 27 and 30 recite updating transaction data and dollar amount of
> purchases associated with a unique customer identification. We make
> reference to our findings, supra, with respect to Creekmore, as discussed with
> respect to claim 8. In addition, we find that Bigari is directed to implementing
> credit purchases at locations which require rapid throughput of transaction
> events (col. 3, lines 11-15). An object of the invention is to produce credit
> vouchers remote from the point of purchase station (cash register) (col. 3, lines
> 23-25 and 33-39). A charge card reader receives a customer credit card and
> transmits customer identification to a host institution. In response to an
> approval signal, a print signal is produced resulting in the printing of a
> voucher for a maximum approved charge. The voucher is indexed with both
> transaction data and maximum approved charge data. The customer endorses
> the voucher, still at the location remote from the point of purchase station.
> The voucher thus becomes valid for the maximum amount of the proposed
> charge. The card holder only then approaches the point of purchase station,

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and places their order. The transaction is then totaled. The attendant at the point of purchase updates the voucher for an actual update amount, which is less than or equal to the maximum purchase amount approved by the host institution (col. 4, lines 1-28).

From this disclosure of Bigari, we find that Bigari's voucher apparatus is remote from the point of purchase, just as the check verification terminal of Creekmore is near but not at the point-of-sale terminal (see also col. 6, lines 14-17 of Bigari). However, although not brought to our attention by either the examiner or appellants, we find that Bigari additionally discloses (col. 9, lines 55-61) that figures 5 through 8 [sic, 7] disclose an enhanced payment voucher processing apparatus and system wherein the point of purchase register is integrated with the payment voucher processing apparatus 10 (underlining added). From the disclosure that the payment voucher processing apparatus may either be remote from the cash register or integrated with the cash register, we find that an artisan would have been motivated to integrate the check verification terminal of Creekmore integral with the point-of-sale terminal, permitting the check approval, based on prior transactions of a customer including the dollar amounts of checks previously presented, to be sent to the point-of-sale terminal. Accordingly, although we consider Off and Tai to be cumulative to the teachings of Creekmore and Bigari, we find that the teachings of Creekmore and Bigari suggest the limitations of claim 17.

In response to the Board decision, Claims 17, 22, 27, 30, 33, and 34 have been amended to clarify that the database defined in these independent claims is stored local to a point-of-sale, and is updatable from a global database concatenated from multiple store databases including the transaction data from prior transactions of the customers at multiple stores.

One exemplary implementation of the present invention is shown in Applicants' Figure 1 in which a transaction processor 112, having disk storage 114, is connected locally to the point-of-sale transaction terminals 120 via a network bus 118 within the exploded view processing system 10, and is connected to a host 110 where global database information can reside. The specification describes that:

The check processing system is located at a store, and maintains a local customer database for that store. For a multiple store business, a local

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system is located at each store and global customer information transfers are
used to supplement the essentially local customer database.[1]

The specification describes the need for improving the efficiency in check verification

processes by maintaining a local customer database containing transaction information about

the store's customers.[2]   The specification discloses that:

> Moreover, because the check transactional data is generated and
> maintained locally, it provides significant information about the store's
> customers over and above the information necessary for check verification risk
> management. New customers are readily identified, and frequency and dollar
> volume information may be used to establish customer profiles and to target
> advertising, marketing and promotional programs, and for other customer
> relations purpose.[3]

In the implementation of the present invention involving multiple stores, information

in the local customer databases are sent at selected intervals to a host site to form the global

customer information, of which selected global customer information is transmitted back to

the stores.[4]   Such a global exchange of customer information reduces the likelihood that a

business will experience a significant loss from a concerted bad check writer.[5] Yet, the

maintenance of the local customer databases provides flexibility to the individual store

managers/operators to use the information contained therein, as noted above.

Applicants submit that the feature of a database local to a point-of-sale and updatable

from a global database concatenated from multiple store databases including the transaction

data from prior transactions of customers at multiple stores is not disclosed or suggested in

the prior art of record.

Figure 1 of Bigari shows a microprocessor 12, from which the vouchers are

generated, remotely connected by a transmitter/receiver 16 to the host institution 14.   Bigari

discloses that:

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[1] Specification, page 18, lines 5-10.
[2] Specification, page 5, lines 3-13.
[3] Specification, page 11, 4-12
[4] Specification, page 11, line 13 to page 12, line 8.
[5] Specification, page 32, lines 2-5.

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According to the present invention, then, a system for implementing credit purchases is provided between a customer, a host institution and a merchant member affiliated with the host institution. Integral to this system is a payment voucher apparatus *located remotely from the point of purchase station* (typically a cash register). This payment voucher apparatus is adapted for use in conjunction with a family of charge cards wherein customers who have a respective member of said family of charge cards can execute transactions in order to obtain a guaranteed voucher for a selected ceiling amount for use in purchasing goods or services from the merchant. This system also *relies upon the existence of a host institution* with which the merchant member is affiliated and wherein the host institution administers accounts for the family of charge cards and issues an approval/disapproval status for a proposed credit charge and further guarantees payment of the proposed charge when a merchant member receives an approval thereof.[6] [emphasis added]

Thus, in Bigari, the databases disclosed are *located remotely from the point of purchase station*, and not stored locally at a point-of-sale, as for example within a store of the merchant. Hence, in Bigari, the only disclosed databases are similar to the claimed global databases and not the claimed database local to a point-of-sale. Further, the payment voucher system in Bigari interacts between the customer and the host institution to provide payment guarantees to the merchant, leaving the store owner/manager without access to the archived database information and dependent on the host institution verification. Accordingly, Applicants submit that there is no disclosure or suggestion in Bigari for a database stored locally at a point-of-sale and updatable from a global database concatenated from multiple store databases including transaction data from prior transactions of customers at multiple stores, as defined in independent Claims 17, 22, 27, 30, 33, and 34.

Further, the deficiencies in Bigari are not overcome by Creekmore.

Creekmore describes a check verification system between customers and a "remotely-located" transaction processor having a file of customers who are entitled to verify checks with the system.[7]   Creekmore disclose in the Abstract that:

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[6] Bigari, col. 3, lines 33-52.
[7] Creekmore, Abstract.

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The system utilizes a number of local point-of-use terminals which are operated by the customer, and which communicate with a *remotely-located* transaction processor including a positive file of customers who are entitled to verify checks with the present system. [emphasis added]

Indeed, Figure 1 of Creekmore shows that transaction processor 19 from which check verifications issue is connected to input terminals in the store by a datalink 18.

Creekmore disclose that:

... The data link 18 is, in many applications of the present system, provided by dedicated telephone lines interconnecting the several input terminals 13 with the transaction processor, although dial-up lines can be used if the greater delay can be tolerated.[8]

Moreover, Creekmore disclose that:

A merchant master file 11 is provided which contains the identity of each merchant or other retail outlet subscriber to the present check verification system, and such merchant information typically includes the number and locations of input terminals which are located in the stores of each merchant-subscriber. It will be appreciated that a particular merchant-subscriber to the present check verification system might be a chain of retail grocery stores having many individual stores located within the trading area *covered by a particular system, with at least one input terminal being located within each such store of that merchant.*[9] [emphasis added]

Thus, like Bigari, the databases in Creekmore are remotely-located from the customer at the store and managed by a central transaction processor. Hence, in Creekmore, the disclosed databases are also similar to the claimed global databases and not the claimed database local to a point-of-sale. Accordingly, Applicants submit that there is no disclosure or suggestion in Creekmore for a database stored locally at a point-of-sale and updatable from a global database concatenated from multiple store databases including transaction data from prior transactions of customers at multiple stores, as defined in independent Claims 17, 22, 27, 30, 33, and 34.

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[8] Creekmore, col. 11, lines 24-28.
[9] Creekmore col. 5, lines 3-14.

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While the Board considers the teachings of Off et al and Tai to be cumulative to the

teachings of Creekmore and Bigari, Applicants submit that like Creekmore and Bigari,

neither Off et al nor Tai disclose utilization of a local database updatable from a global

database concatenated from multiple store databases including transaction data from prior

transactions of customers at multiple stores.

Off et al show in Figure 1, a database 22 of host computer 16 and files 14 of a store

controller 10. However, there is no disclosure or suggestion in Off et al that the files 14 local

to the point-of-sale are updatable from a global database including transaction data from prior

transactions of the customers at multiple stores. Off et al disclose that:

> The store controller 10 is coupled to a retailer host computer 16, as
> indicated by line 18, which may be a telephone line or some other
> communication link. The retailer host computer 16 controls communications
> with all store controllers in the retailer's various stores, and is responsible for
> generating various accounting reports, as indicated at 20. The retailer host
> computer 16 has an associated data base 22 of various files relating to the
> retailer's entire store operations.

Off et al further disclose that:

> Maintenance of the controller files used in coupon creation and
> redemption is effected by means of a sequential maintenance file, which may
> be prepared at a site remote from the store, and then processed at the store
> controller to effect the desired changes in the files. The maintenance functions
> include adding, deleting or replacing coupon deal records and coupon index
> records, enabling and disabling coupon triggering by item, enabling and
> disabling coupon printing by item, copying the coupon by file, and retrieving
> the coupon counts. Other functions include reorganizing the coupon-look-up
> file, clearing the file before a reload, and adding or replacing system
> configuration data. The latter function includes enabling or disabling coupon
> creation by coupon deal, enabling or disabling printing by store or checkout
> lane, enabling or disabling triggering by store or checkout lane, enabling or
> disabling coupon validation but continuing to log redemptions and
> misredemptions, updating a per-transaction coupon maximum, by checkout
> lane, and updating a transaction threshold.

Thus, the updating in Off et al comes from a sequential maintenance file that modifies

the coupon deal records and coupon deal records, and not from a file that includes transaction

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data from prior transactions of the customers at multiple stores. Accordingly, Applicants

submit that there is no disclosure or suggestion in Off et al for a database stored locally at a

point-of-sale and updatable from a global database concatenated from multiple store

databases including transaction data from prior transactions of customers at multiple stores,

as defined in independent Claims 17, 22, 27, 30, 33, and 34.

Meanwhile, Tai discloses:

> ... system and methodology for identifying the heaviest product
> purchasers who regularly use coupons and determining their promotional
> behavior response patterns of which involves initially preparing a list of names
> and addresses of consumers who are the most likely heaviest product
> purchasers who are regular coupon users and then delivering to them a
> plurality of product purchase incentives such as cents off coupons.[10]

Tai further disclose that:

> By including machine readable data relative to the product, such as size,
> price, etc., on every delivered coupon and by periodically delivering additional
> purchase incentive offers and consumer activated encoding devices to the
> refined list of consumer names and addresses and analyzing the redemption
> characteristics of the various purchase incentive offers, consumer promotional
> behavior response patterns of heavy shopping households can be determined
> and thus consumer promotional behavior response patterns can be predicted
> with a high degree of accuracy.[11]

Hence, Tai is directed to coupon features such as the disclosed consumer activated

encoding devices that permit consumer promotional behavior response patterns to be

accurately predicted, and provide no disclosure or suggestion for utilization of a local

database updatable from a global database concatenated from multiple store databases

including transaction data from prior transactions of customers at multiple stores.

Accordingly, Applicants submit that there is no disclosure or suggestion in Tai for a database

stored locally at a point-of-sale and updatable from a global database concatenated from

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[10] Tai, Abstract.
[11] Tai, col. 3, lines 51-61.

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multiple store databases including transaction data from prior transactions of customers at multiple stores, as defined in independent Claims 17, 22, 27, 30, 33, and 34.
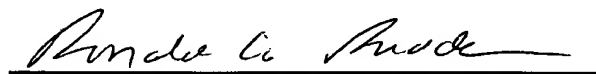
M.P.E.P. § 2143 requires for a *prima facie* case of obviousness that the prior art reference (or references when combined) must teach or suggest all the claim limitations. With no disclosure or suggestion for a database stored locally at a point-of-sale and updatable from a global database concatenated from multiple store databases including transaction data from prior transactions of customers at multiple stores, Applicants respectfully submit that independent Claims 117, 22, 27, 30, 33, and 34 and the claims dependent therefrom patentably define over the applied prior art.

Consequently, in view of the present amendment and in light of the above discussions, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Robert C. Mattson
Attorney of Record
Registration No. 42,850
Ronald A. Rudder, Ph.D.
Registration No. 45,618

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

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